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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 10/665,365 | 09/22/2003 | Nirupama Karunaratne | 056365-5048 | 4895 |
| 9629 | 7590 | 09/21/2007 | EXAMINER | |
| MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004 | | | FLETCHER III, WILLIAM P | |
| | | ART UNIT | PAPER NUMBER | |
| | | 1762 | | |
| | | MAIL DATE | DELIVERY MODE | |
| | | 09/21/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/665,365 | KARUNARATNE ET AL. | |
| | Examiner | Art Unit | |
| | William P. Fletcher III | 1762 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 25 June 2007.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 13-15,20,23 and 25-28 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 13-15 20 23 25-28 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application
 6) Other: _____.

DETAILED ACTION

Response to Amendment

1. The compliant amendment filed June 25, 2006, and the remarks filed April 3, 2007, are noted with appreciation.
2. Claims 13-15, 20, 23, and 25-28, remain pending.

Terminal Disclaimer

3. The terminal disclaimer filed on April 3, 2007, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 11/417,162 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

4. The objections set forth in the prior Office action are withdrawn in view of the amendment.
5. The obviousness-type double patenting rejections, set forth in the prior Office action, are withdrawn in view of the terminal disclaimer.
6. The amendment has incorporated the features of previously pending dependent claim 24 into independent claim 13. Since previously pending claim 24 had been rejected under 35 USC 103(a), the rejections under 35 USC 102(b) set forth in the prior Office action are withdrawn. New rejections under 35 USC 103(a), necessitated by the amendment, are set forth herein below.
7. Applicant is reminded that differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence

indicating that such concentration is critical; it is not inventive to discover the optimum or workable ranges by routine experimentation. MPEP 2144.05(II)(A). In the instant case, the relative concentrations of binder and pigment in a coating composition (paint) are result-effective variables effecting the properties of the resultant coating (paint) such as viscosity, curing/cross-linking rate, color, effect, and hiding power. As such, it would have been obvious to optimize such result-effective variables by routine experimentation absent evidence of unexpected results demonstrating the criticality of the claimed concentrations. As no such evidence has been presented, Applicant's arguments are not persuasive.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
10. **Claims 13, 14, 20, 23, and 25-28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyatake et al. (US 2002/0043464 A1).**

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- A. Miyatake is applied herein as set forth in the prior Office action.
- B. It would have been obvious to one of ordinary skill in the art to optimize the relative concentrations by routine experimentation as explained above.

11. **Claims 13-15, 20, 23, and 25-28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler et al. (US 4,978,708 A).**

- A. Fowler is applied herein as set forth in the prior Office action.
- B. It would have been obvious to one of ordinary skill in the art to optimize the relative concentrations by routine experimentation as explained above.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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13. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 0900h-1700h.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William Phillip Fletcher III/

Primary Examiner

September 16, 2007